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CURTIS L. SCHRANDT

AF/3712
R. Kent
8/8/02
#10 / Reply
Brief

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES**

APPLICANT(S) : Peter J. WILK
SERIAL NO. : 09/661,520J
FILED : 09/13/00
FOR : Sea Shell Novelty Item
GROUP ART UNIT : 3712
EXAMINER : K. Nguyen

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TECHNOLOGY CENTER R3700

Commissioner for Patents
Washington, D.C. 20231

REPLY BRIEF

noted

The Examiner contends, on pages 5 and 6 of the Examiner's Answer, that the device of Saitoh is capable of performing the intended use of Appellant's invention. Appellant disputes this contention. The sensor of Saitoh has a structure (e.g., sensitivity) designed to activate the sound reproduction elements of Saitoh's animated singing toy bird as soon as a person approaches the device. That sensor is incapable of "waiting" until an ear of the user is positioned next to the device, as recited in certain claims on appeal in this case. In fact, one of ordinary skill in the art would not wish to use a sensor capable of carrying out appellant's method. Birds do not wait to sing until a person's ear is placed next to the bird.

The Examiner cites cases in support of the statement that "[i]n a claim drawn to a process of making, the intended use must result in a manipulative difference as compared to the prior art." None of appellant's claims is directed to a process of making. Moreover, several of the claims on appeal do recite a "manipulative difference" in that appellant's sea shell housing must be manipulated (lifted from a support surface) to activate the device. In contrast, Saitoh does not contemplate, nor would one of ordinary skill in the art contemplate, that the animated singing toy bird of Saitoh would sing only upon a manipulating of the toy.

As set forth in appellant's Brief on Appeal, Saitoh does not suggest appellant's invention as set forth in independent claims 1, 7, 10, or 14 and the combination of Saitoh and Curran does not suggest appellant's invention as set forth in independent claims 13, 17, or 18. The rejections of claims 1-18 under 35 U.S.C. § 103 are improper should be reversed.

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Respectfully submitted,

COLEMAN SUDOL SAPONE, P.C.

Dated: July 18, 2002

By:



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